

REMARKS

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 1-40 were pending in the application, of which Claims 1, 15, and 28 are independent. In the Office Action dated September 22, 2004, Claims 15 and 19-27 were rejected under 35 U.S.C. § 101, Claims 7, 20, and 33 were rejected under 35 U.S.C. § 112, Claims 1-5 and 7-40 were rejected under 35 U.S.C. § 103, and Claim 6 was allowed. Following this response, Claims 1-40 remain pending in this application. Applicant hereby addresses the Examiner's objection and rejections in turn.

I. **Objection to the Abstract**

In the Office Action dated September 22, 2004, the Examiner objected to the Abstract of the Disclosure as being improper. The Abstract has been replaced with a Substitute Abstract attached to this Amendment, and Applicants respectfully submit that the Substitute Abstract overcomes this objection and adds no new matter.

II. **Objection to the Specification**

In the Office Action, the Examiner objected to the specification due to missing status information of a co-pending application. The specification has been amended, and Applicant respectfully submits that the amendment overcomes this objection and adds no new matter.

III. Rejection of the Claims Under 35 U.S.C. § 112, Second Paragraph

In the Office Action, the Examiner rejected Claims 7, 20, and 33 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention. Claims 7, 20, and 33 have been amended, and Applicant respectfully submits that the amendment overcomes this rejection and adds no new matter.

IV. Rejection of the Claims Under 35 U.S.C. § 101

In the Office Action, the Examiner rejected Claims 15 and 19-27 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claim 15 has been amended and Applicant respectfully submits that the amendment overcomes this rejection and adds no new matter. Support for this amendment can be found in the specification at least in paragraphs 45 and 59. As claims 19-27 depend upon claim 15, Applicant further submits the amendment overcomes the rejection of claims 19-27 as well.

V. Rejection of the Claims Under 35 U.S.C. § 103(a) Using *Huang*

In the Office Action, the Examiner rejected Claims 1-5 and 7-40 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,995,991 ("*Huang*") in view of what the Examiner alleges is obvious to a person having ordinary skill in the art. Applicant respectfully traverses this rejection.

Regarding Claim 1, the Examiner stated that *Huang* does not specifically disclose an analyzer circuit configured to determine a first status of a first floating point operand and a second status of a second floating point operand. (See Office Action,

page 3, lines 20-22.) In addition, the Examiner merely states that this missing element would be obvious to a person having ordinary skill in the art. (See Office Action, page 4, lines 3-7.) As a result, Applicant respectfully suggest that the Examiner has failed to make a *prima facie* case of obviousness. In order to make a *prima facie* case of obviousness, the Examiner must set forth prior art which teaches or suggests every claim limitation. (See MPEP § 2143.)

If the Examiner continues to rely on this unsupported contention, Applicant respectfully requests the Examiner to provide concrete and explicit support.

Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy (February 21, 2002)(stating that it is never appropriate to rely on common knowledge without evidentiary support as sole or principal evidence on which to base rejection); MPEP § 706 citing 37 C.F.R. § 1.104 (providing that when a rejection in an application is based on facts within the personal knowledge of an Examiner, the data should be stated as specifically as possible, *and the facts must be supported*, when called for by the applicant, by an affidavit from the Examiner); MPEP § 2144.03 (providing that the Examiner may only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art and, if the Applicant traverses such an assertion, the Examiner *should cite a reference* in support of his or her position.).

In light of the above remarks, Applicant asserts that the rejection of Claim 1 is not supported by the cited art and withdrawal of the rejection is respectfully requested. Applicant asserts that the rejections of Claims 15 and 28 are also not supported by the

cited art and should be withdrawn for the reasons outlined above in response to the rejection of Claim 1.

Dependent Claims 2-5, 7-14, 16-27, and 29-40 are also allowable at least for the reasons above regarding independent Claims 1, 15, and 28, and by virtue of their respective dependencies upon independent Claims 1, 15, and 28. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims 2-5, 7-14, 16-27, and 29-40.

VI. Rejection of the Claims Under 35 U.S.C. § 103(a) Using *Lynch*

In the Office Action, the Examiner rejected Claims 1-5 and 7-40 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,009,511 ("*Lynch*") in view of what the Examiner alleges is obvious to a person having ordinary skill in the art. Applicant respectfully traverses this rejection.

Regarding Claim 1, the Examiner stated that *Lynch* does not specifically disclose an analyzer circuit configured to determine a first status of a first floating point operand and a second status of a second floating point operand. (See Office Action, page 5, lines 17-19.) In addition, the Examiner merely states that this missing element would be obvious to a person having ordinary skill in the art. (See Office Action, page 6, lines 2-6.) As a result, Applicant respectfully suggest that the Examiner has failed to make a *prima facie* case of obviousness. In order to make a *prima facie* case of obviousness, the Examiner must set forth prior art which teach or suggest every claim limitation. (See MPEP § 2143.

If the Examiner continues to rely on this unsupported contention, Applicant respectfully requests the Examiner to provide concrete and explicit support.

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In light of the above remarks, Applicant asserts that the rejection of Claim 1 is not supported by the cited art and withdrawal of the rejection is respectfully requested. Applicant asserts that the rejections of Claims 15 and 28 are also not supported by the cited art and should be withdrawn for the reasons outlined above in response to the rejection of Claim 1.

Dependent Claims 2-5, 7-14, 16-27, and 29-40 are also allowable at least for the reasons above regarding independent Claims 1, 15, and 28, and by virtue of their respective dependencies upon independent Claims 1, 15, and 28. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims 2-5, 7-14, 16-27, and 29-40.

VII. Conclusion

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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